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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,286	06/22/2001	Ronald A. Katz	6646-101D7	9210

7590 05/20/2003

Attention: Reena Kuyper  
A2D, L.P.  
Suite 315  
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Los Angeles, CA 90069

EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 05/20/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/888,286

Applicant(s)

KATZ, RONALD A.

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on April 28, 2003 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/888,286 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Terminal Disclaimer***

2. The terminal disclaimer filed on April 28, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of pending Application Number 08/305,822 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 24-26, 28-33, 35, 36, 38-41, 43 and 45-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barr et al. ('530) in view of Roberts et al. ('553).

Barr et al. disclose the claimed invention including a product (10- ticket) for use with a telephone-interface system accessed through a telephone communication facility; the ticket being a base substrate having telephone number data indicative of a toll free

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number ("800-999-1000", "800-886-5000", "800-123-9000" - see figs. 1a, 1b, 2 and 3) which is to be entered by a caller via a telephone; the indicia (20) being unique identification data ("The number in the game area 20 may be different from the other number in other cards", see col. 2, lines 60-62; therefore, game area provides unique identification data); the substrate having additional data (30) printed thereon; obscuring means (22, 32) for obscuring the indicia; the obscuring means being provided over at least a portion of the unique identification data (as seen in figure 1); and the substrate further including another unconcealed indicia ("INSTRUCTIONS", as seen in figures 1, 1a, 1b, 2 and 3).

Barr et al. disclose the claimed invention except for the indicia including a visual symbolic graphic representation and the additional data including a machine-readable code.

Roberts et al. disclose lottery tickets having visual symbolic graphic representation (14) that is also represented in machine-readable format (16). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Barr's invention to include graphic and machine readable indicia, as taught by Roberts et al., to provide indicia that is both aesthetically pleasing to the eye and provides tamper-proof capabilities for ensuring proper use of the lottery tickets.

As to the indicia on the substrate serving as a consumable key (claims 24 and 29) or telephone number data relating to called terminal digital data (claims 30 and 31) or the unique identification data being tested by a telephonic-interface control system to provide an indication of that limits (one time only use – claims 38 and 46; up to an

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extent of a limited dollar value – claims 40 and 48; during a defined interval of time – claims 45 and 47) specified on the use of the products that have been satisfied before allowing the callers to gain access to the at least certain operations of the specific telephone processing format (claims 32 and 41), the Examiner finds no new and unobvious functional relationship between the printed matter and the substrate upon which it is placed. That is, the relationship of the printed matter and the substrate merely set forth one of support and display. Accordingly, the content of the printed matter called for does not patentably distinguish over the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983) and *In re Miller*, 418 F. 2d 1392, 164 USPQ 46 (CCPA 1969).

Regarding claims 32, 33, 35, 36 and 38-40, see the above rejections. Further, Barr et al., as modified by Roberts et al., disclose providing a plurality of products for use with a telephone-interface system accessed through a telephone communication facility (see col. 1, lines 14-17 – "... a game comprising one or more tickets...").

5. Claims 27, 34, 37, 42 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barr et al. in view of Roberts et al. and further in view of Goldman et al. ('708).

Barr et al., as modified by Roberts et al., disclose the claimed invention except for the substrate having a value assigned to the product.

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Goldman et al. disclose lottery tickets having a value assigned (12 - \$1) to the ticket.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Barr's invention to include a value assigned thereto, as taught by Goldman et al., to visually provide the customer with an indication of price for the lottery tickets such that the customer would not have to rely on the seller to provide pricing information.

### ***Response to Arguments***

6. Applicant's arguments filed April 28, 2000 have been fully considered but they are not persuasive.

Applicant incorporates by reference, his prior reasons and arguments that point out the differences between the pending claims and the references asserted by the examiner. Therefore, the examiner, also, maintains and incorporates by reference, her prior line of reasoning as set forth in the previous Office action (Paper No. 9).

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

May 16, 2003

*Monica B. Carter*  
**MONICA CARTER**  
**PATENT EXAMINER**